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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/867,618      | 05/31/2001  | Naoki Watanabe       | 500.40173X00        | 7069             |

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

BAYARD, DJENANE M

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2141

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,618

Applicant(s)

WATANABE ET AL.

Examiner

Djenane M. Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/22/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. This is in response to amendment filed on 2/1/05 in which claims 1-4, 6-8 and 11-13 are pending. Applicant's arguments with respect to claims 1-4, 6-8, 11-13 have been considered but are moot in view of the new ground(s) of rejection. Therefore, this case is made Final.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-8 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 6,611,830 to Shinoda et al.

a. As per claims 1 and 12, Shinoda et al teaches a method of aiding portal site making comprising the steps of: preparing a plurality of mount files each mount file including mount image information and a mount type information (See col. 4, lines 1-15); displaying the mount

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image information one of said plurality of mount files in accordance with selection by a user (See col. 5, lines 57-61); preparing a plurality of image/information files indicative of various services each image/information file including a small size image representing each of said services and information items relating to the service each information item relating to a mount type (See col. 3, lines 1-6).; and mounting said small-size images of image/information files on said displayed mount image information in accordance with operation by the user wherein, when said small -size image of said image/information file is designated by the user on said mount image information, said information item which mount type coincides with said mount type information in said mount file is displayed. (See col. 3, lines 25-35).

b. As per claim 8 and 13, Shinoda et al teaches displaying a portal site in which image/information files indicative of various services are mounted on a mount including a mount type, each image/information file including a small-size image representing each of said services and information items relating to the service, each information item relating to a mount type (See col. 3, lines 1-6); and comparing, when said small-size image of said mount with the mount type of each information item included in said mount with the mount type of each information item included in said designated image/information file to display coincident information item (See col. 3, lines 25-35).

c. As per claim, 12, Shinoda et al teaches a program for aiding portal site making comprising code for executing the following steps of displaying a plurality of mount files, each mount file including mount image information and a mount type information; displaying the

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image information of one of said plurality of mount files in accordance with selection by a user (See col. 5, lines 57-61); preparing a plurality of image/information files indicative of various services, each image/information file including a small size image representing each of said services and information items relating to the service, each information item relating to a mount type (See col. 3, lines 1-6); mounting said small size image of said image/information file is designated by the user on said mount image information, said information item which mount type coincides with said mount type information in said mount file (See col. 3, lines 25-35).

d. As per claims 2, Shinoda et al teaches the claimed invention as described above. Furthermore, Shinoda et al teaches wherein each of said image/information files is made by embedding information items in the small size image for identifying the various services through digital watermarking (See col. 6, lines 7-28).

e. As per claim 3, Shinoda et al teaches the claimed invention as described above. Furthermore, Shinoda et al teaches wherein the information items of said image/information file include a service menu and URLs corresponding to individual items of the menu (See col. 6, lines 29-41)

f. As per claim 4, Shinoda et al teaches the claimed invention as described above. image/information files are provided through a network (See col. 2, lines 60-62).

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g. As per claim 6, Shinoda et al teaches the claimed invention as described above.

Furthermore, Shinoda et al teaches wherein the operation by said user is drag and drop of said small – size image of said image/information file (It is inherent that the operation is drag and drop by the user in order to duplicate the mark image, See col. 6, lines 48-50)

h. As per claim 7, Shinoda et al teaches the claimed invention as described above.

Shinoda et al teaches wherein said mount file is of a HTML format. Furthermore, Shinoda et al fails to teach when said small –size image of said image/information file is dragged and dropped, a statement defining dropped coordinates and an image/information file name is inserted into said mount file (It is inherent that the operation is drag and drop by the user in order to duplicate the mark image, See col. 6, lines 48-50).

i. As per claim 11, Shinoda et al teaches the claimed invention as described above.

Furthermore, Shinoda et al teaches linking to a URL of the menu item included in said image/information file in accordance with selection of the menu item by the user (See col. 4, lines 47-55).

### *Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M. Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner

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RUPAL DHARIA  
SUPERVISORY PATENT EXAMINER